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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,032	06/29/2001	Christoph Seidel	HUBR-1067.3 DIV	2111
24972	7590	04/14/2005	EXAMINER	
FULBRIGHT & JAWORSKI, LLP 666 FIFTH AVE NEW YORK, NY 10103-3198			BROWN, TIMOTHY M	
			ART UNIT	PAPER NUMBER
			1648	
DATE MAILED: 04/14/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/896,032	Applicant(s) SEIDEL ET AL.	
	Examiner Timothy M. Brown	Art Unit 1648	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 40-48.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

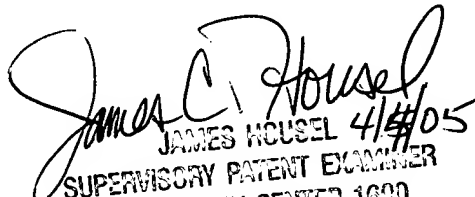
REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☒ Other: PTO-892 attached.

Continuation of 5. Applicant's reply has overcome the following rejection(s): the rejection of claims 40-48 under 35 U.S.C. 112, second paragraph.

Continuation of 11. does NOT place the application in condition for allowance because: Applicants' remarks do not overcome the enablement rejection of claims 40-48. Applicants argue the Examiner has not met the burden of showing that the claimed invention is unlikely to function. The Examiner respectfully submits the claimed invention does not enjoy such a presumption. Applicants rely on In re Marzocchi which states the specification "must be taken as in compliance with the enabling requirement . . ." when it teaches how to make and use the invention "in terms which correspond to those used in describing and defining the subject matter sought to be patented" Marzocchi is not persuasive in Applicants' case because the specification does not teach how to use the invention "in terms that correspond in scope" with the claims. Applicants' method permits any modification to be made to any and all cysteine residues of the NS3 protein. The specification, however, only teaches making covalent modifications to specific NS3 cysteine residues. Because the scope of the claims does not correspond to the teachings of the specification, Marzocchi's presumption of enablement does not apply.

It is worth noting that if the Examiner had the burden of showing that the invention is unlikely to function, the state of the art would support such a finding. Claims 40-48 were rejected for lacking enablement because the specification does not teach how to maintain the antigenicity of the NS3 polypeptide, while making various modifications to the NS3 cysteine residues. Research by Mangold et al. (Virol. (1995) 211, 535-543) shows that cysteine modifications have a profound impact on the antigenicity of the envelope protein of viral proteins. Their work shows that the ability of antibody to detect HBV envelope protein is compromised by the deletion of just two cysteine residues. Thus, Applicants' modification of each cysteine residue (such as by deletion) would more likely than not destroy the antigenicity of the NS3 protein.


JAMES HOUSEL 4/4/05
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1000

TMB
3/25/05